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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,082	01/29/2007	Davy Jacobs	S1022.71021US00	6131
46329	7590	10/02/2009		
STMicroelectronics Inc. c/o WOLF, GREENFIELD & SACKS, P.C. 600 Atlantic Avenue BOSTON, MA 02210-2206			EXAMINER VERDI, KIMBLEANN C	
			ART UNIT 2194	PAPER NUMBER
			MAIL DATE 10/02/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,082	<b>Applicant(s)</b> JACOPS ET AL.	
	<b>Examiner</b> KimbleAnn Verdi	<b>Art Unit</b> 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/16/2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/16/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 1-19 are pending in the current application.

***Drawings***

2. The drawings are objected to because of the following:
  - a. Figures 1, 2a, 2b, and 5-7 are not legible;
  - b. Figures 1-3 and 5-7 contain reference characters (118, 218, 318, 418, 618, 718, 818), which are not oriented in the same direction as the view.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 418, Figure 3 and 518, Figure 4.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

5. Claims 1-16 objected to because of the following informalities:
  - a. Claim 1, line 2, claim 14, line 1, claim 17, line 1, the recitation of "SW" should be --Software (SW)--;
  - b. Claim 1, line 3, the recitation of "the library providing", should be --the library further comprising--;
  - c. Claim 5, line 1 and claim 15, line 2, the recitation of "HCI", should be --Host Controller Interface (HCI)--;
  - d. Claim 10, line 1, the recitation of "The telecommunications device with", should be --The telecommunications device comprising:--;
  - e. Claim 12, line 2, claim 14, line 1, claim 17, line 3, and claim 19, line 1, the recitation of "API", should be --Application Programming Interface (API)--;
  - f. Claim 14, line 1, the recitation of "An API for providing", should be --An Application Programming Interface (API) comprising: providing--
  - g. Claim 15, line 1, the recitation of "An API", should be --The API--;
  - h. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**7. Claim 3 and 10-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**8. Regarding claims 10, 14, 17, and 18**, the phrase "optionally" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**9. Claims 11-12, 15-16, and 19** did not cure the deficiencies of claims 10, 14, 17, and 18.

**10. Claim 3** contains the trademark/trade name BLUETOOTH™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a telecommunications module and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**12. Claims 10-12 and 18-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

13. **Claim 10** recites a “telecommunications device” however; it appears that a telecommunications device would reasonably be interpreted by one of ordinary skill in the art as software, per se since the body of the claim appears to be software.

Applicant claims an interface, layers of a telecommunications protocol, and optionally any hardware available as described by Applicant's specification, appear to be software structures since the hardware is optional. However, software structures are nonstatutory when claimed without reciting a tangible embodiment of the system.

Applicant describes the functionality of an interface, layers of a telecommunications protocol but does not disclose any hardware structure. As such, it is believed that a telecommunications device of claim 10 is reasonably interpreted as not limited to a practical application, per se and non statutory.

14. **Claims 11-12** did not cure the deficiencies of claim 10.

15. **Claim 18** is directed to a process (method), however, the process is not limited to a particular practical application and does not pass the machine-or-transformation test

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since there is no tie to a particular machine or a particular transformation of a particular article to a different state or thing, as such the claims are not directed to statutory subject matter.

In contrast, a process claim which explicitly recites the particular machine or apparatus, recites a step that inherently involves the use of a particular machine or apparatus, or particularly transforms a particular article to a different state or thing is therefore directed to statutory subject matter.

Appropriate correction or amendment is required.

16. **Claim 19** did not cure the deficiencies of claim 18.

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. **Claims 1-19 are rejected under 35 U.S.C. 102(b) as being unpatentable by Motorola (“JAVA™ APIs for BLUETOOTH™ Wireless Technology (JSR-82)”.**

19. **As to claim 1**, Motorola teaches a library of software program products, the library comprising a set of routines (javax.bluetooth package, page 11, section 3.3.1, lines 1-10) for an embedded software application (game application, pages 5 and 6,

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section 2.2.4, lines 1-15) requiring software (SW) protocol layers (page 6, section 2.3, lines 7-11), profiles (pages 6 and 7, section 2.3, lines 12-16) or application code (BLUETOOTH™ Control Center, page 5, section 2.2.3, lines 16-19) embedded on a processor (page 5, section 2.2.2, lines 1-8), the library providing an interface (JSR-82) between the software application running on the processor (game application, pages 5 and 6, section 2.2.4, lines 1-15) and the SW protocol layers (BLUETOOTH™ Protocols) and/or the profiles (BLUETOOTH™ profiles) or the application code (page 1, Section 1.2.1, lines 9-11).

20. **As to claim 2**, Motorola teaches wherein the interface (JSR-82) is between the software application running on the processor (game application, pages 5 and 6, section 2.2.4, lines 1-15) and a telecommunications module (BLUETOOTH™ protocol, page 6, section 2.2.4, lines 7-10).

21. **As to claim 3**, Motorola teaches wherein the telecommunications module is a BLUETOOTH™ lower layer SW protocol (BLUETOOTH™ protocol, page 6, section 2.2.4, lines 7-10).

22. **As to claim 4**, Motorola teaches wherein the interface uses telecommunications controller interface communications (HCI, Figure 3-1).



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23. **As to claim 5**, Motorola teaches wherein the communications are HCI communications (HCI , Figure 3-1) for communication with the telecommunications module (L2CAP, Figure 3-1).

24. **As to claim 6**, Motorola teaches wherein the software application (game application, pages 5 and 6, section 2.2.4, lines 1-15) communicates (using BLUETOOTH™ communications, page 6, section 2.2.4, lines 7-10) with a telecommunications module (L2CAP, page 6, section 2.3, lines 5-8) for executing a telecommunications protocol (establish L2CAP connection, page 7, section 2.3, lines 21-24).

25. **As to claim 7**, Motorola teaches wherein the software application (game application, pages 5 and 6, section 2.2.4, lines 1-15) communicates with a hardware input/output interface (phone or PDA, section 2.2.4, page 6, lines 11-15).

26. **As to claim 8**, Motorola teaches a computer readable medium (memory, section 2.2.2, page 5, lines 4-5).

27. **As to claim 9**, Motorola teaches wherein the medium is a CD-ROM or DVD-ROM or a memory or data storage device (memory, section 2.2.2, page 5, lines 4-5).

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28. **As to claim 10**, Motorola teaches a telecommunications device (BLUETOOTH™ device, page 5, section 2.2.2, lines 1-12, MIDP device, section 3.3.2, page 11, line1) with an interface (BLUETOOTH™ API, section 3.3.2, page 12, Figure 3-5) towards an underlying operating system (page 12, section 3.3.2, Figure 3-5) , to layers of a telecommunications protocol (BLUETOOTH™ Stack, section 3.3.2, page 12, Figure 3-5) and optionally towards any hardware available for an embedded application (Bluetooth Radio Hardware, section 3.2, page 9, Figure 3-1).

29. **As to claim 11**, this claim is rejected for the same reasons as claim 1 since claim 11 recites the same or equivalent invention, see the rejection to claim 1 above.

30. **As to claim 12**, Motorola teaches wherein the interface is an API (JSR-82, page 4, section 2.1, lines 1-8).

31. **As to claim 13**, this claim is rejected for the same reasons as claim 1 since claim 13 recites the same or equivalent invention, see the rejection to claim 1 above. In addition Motorola teaches a Host processing system (Kiosk or Vending machine, page 6, section 2.2.4, lines 16-36).

32. **As to claim 14**, this claim is rejected for the same reasons as claims 1 and 10 since claim 14 recites the same or equivalent invention, see the rejection to claims 1 and 10 above.

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33. **As to claim 15**, this claim is rejected for the same reasons as claim 5 since claim 15 recites the same or equivalent invention, see the rejection to claim 5 above.

34. **As to claim 16**, this claim is rejected for the same reasons as claim 8 since claim 16 recites the same or equivalent invention, see the rejection to claim 8 above.

35. **As to claim 17**, this claim is rejected for the same reasons as claim 14 since claim 17 recites the same or equivalent invention, see the rejection to claim 14 above

36. **As to claim 18**, this claim is rejected for the same reasons as claim 10 since claim 18 recites the same or equivalent invention, see the rejection to claim 10 above.

37. **As to claim 19**, this claim is rejected for the same reasons as claim 12 since claim 19 recites the same or equivalent invention, see the rejection to claim 12 above.

### ***Conclusion***

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KimbleAnn Verdi whose telephone number is (571)270-1654. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST..

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39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hyung S. Sough/  
Supervisory Patent Examiner, Art Unit 2194  
09/30/09

KV  
September 30, 2009